UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,595	12/18/2000	Eugene Fink	051672-5001	1673

28977 7590 10/27/2005		EXAMINER
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ART UNIT	PAPER NUMBER
3624	

DATE MAILED: 10/27/2005

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PHILADELPHIA, PA   19103-2921

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/737,595	FINK ET AL.
	Examiner	**Art Unit**	
	Narayanswamy Subramanian	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 August 2005*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,10 and 25* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,10 and 25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This office action is in response to applicants' request for continued examination filed on

August 15, 2005. Amendments to claim 1 and addition of new claim 25 have been entered.

Claims 1-7, 10 and 25 are pending in the application and have been examined. The rejections and

response to arguments are stated below.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and
> distinctly claiming the subject matter, which the applicant regards as his invention.

3.   Claims 1-7, 10 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Claim 1 recites the limitation "applying the user-preferences and characteristics of the

second order". It is not clear if the user-preferences are associated with the first order or the

second order. If the user-preferences are associated with the second order, then there is no

antecedent basis for this limitation. Clarification is required. Claims 2-7 and 10 are rejected

because they depend on a rejected independent claim.

Claim 25 recites the limitation "applying the user-preferences and characteristics of each

of the second orders". It is not clear if the user-preferences are associated with the first order or

the second orders. If the user-preferences are associated with the second orders, then there is no

antecedent basis for this limitation. Clarification is required.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the
United States before the invention thereof by the applicant for patent, or on an international application by
another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title
before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA

35 U.S.C. 102(e)).

5.   Claim 25 is rejected under 35 U.S.C. 102(e) as being fully anticipated by Sundaresan et al

(US Patent 6,868,400 B1).

With reference to claim 25, Sundaresan teaches a computer-implemented method to trade

objects over a network, comprising: receiving parameters for a first order from a user for an object

having at least four dimensions (See Sundaresan Column 2 lines 60-63 and Column 7 lines 25-30),

wherein the parameters include at least one range of acceptable values associated with one of the at

least four dimensions (See Sundaresan Column 6 lines 5-9); encoding user-preferences associated

with the first order (See Sundaresan Column 9 line 57 – Column 10 line 21); applying the

parameters to a search engine in order to identify a plurality of second orders associated with an

object having said at least four dimensions (See Sundaresan Column 5 lines 55-61, Column 7 lines

25-40 and Column 14 lines 13-19); applying the user-preferences and characteristics of each of the

second orders to a quality function that outputs a quality value corresponding to each of the second

orders to the user (See Sundaresan Column 6 lines 9-14); and matching said first order with one of

said second orders in accordance with said quality values (See Sundaresan Column 6 line 60 –

Column 7 line 40). The spread function is interpreted to include a quality function and the spread

value is interpreted to include a quality value.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

7.   Claims 1-7, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Sundaresan et al (US Patent 6,868,400 B1) in view of Walsh et al (US Patent 6,144,848).

        With reference to claim 1, Sundaresan teaches a computer-implemented method to

trade objects over a network, comprising: receiving a first order from a user for an object having at

least four dimensions associated with said object (See Sundaresan Column 2 lines 60-63 and

Column 7 lines 25-30); encoding user-preferences associated with the first order (See Sundaresan

Column 9 line 57 – Column 10 line 21); searching a computer memory for a second order with an

object having said at least four dimensions (See Sundaresan Column 5 lines 55-61 and Column 14

lines 13-19); applying the user-preferences and characteristics of the second order to a quality

function that outputs a quality value of the second order to the user (See Sundaresan Column 6

lines 9-14); and matching said first order with said second order in accordance with said quality

value (See Sundaresan Column 6 line 60 – Column 7 line 40). The spread function is interpreted to

include the quality function and the spread value is interpreted to include a quality value.

Sundaresan does not explicitly teach the steps of receiving a message to modify said

first order while said first order is pending, wherein said message is received from a party

associated with the first order and modifying said first order in accordance with said message.

Walsh teaches the steps of receiving a message to modify said first order while said first

order is pending, wherein said message is received from a party associated with the first order and

modifying said first order in accordance with said message (See Walsh Column 7 lines 55-65,

Column 21 lines 10-19 and Column 28 lines 24-39).

Both Sundaresan and Walsh are concerned with the problem of facilitating trade

between buyers and sellers. It would have been obvious to one with ordinary skill in the art at the

time of invention modify Sundaresan to include steps taught by Walsh. The combination of the

disclosures taken as a whole suggests that it would have helped a users make changes to their order

as new information becomes available to them.

With reference to claims 2-4, and 10, Sundaresan teaches the steps wherein said first

order is a buy order and said second order is a sell order (inherent in the disclosure of Sundaresan);

first order is a sell order and said second order is a buy order (inherent in the disclosure of

Sundaresan); the object is at least one of a group comprising goods and services (See Sundaresan

abstract); and if said first order does not match said second order, further comprising adding said

first order to a list of orders (See Sundaresan Column 14 lines 13-19, orders in the queue represent

orders that were not matched).

With reference to claim 7, Walsh teaches the steps of receiving a message to execute said first order using said second order and automatically executing said first and second orders in accordance with said message (See Walsh Column 21 lines 10-19).

8.   Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sundaresan et al (US Patent 6,868,400 B1) in view of Walsh et al (US Patent 6,144,848) and further in view of Autotrader.com (Reference dated July 20, 2000).

With reference to claims 5 and 6, Sundaresan discloses a method to trade objects over a network as discussed in claim 1 above.

Sundaresan does not explicitly teach the steps wherein said object is a vehicle and wherein the dimensions comprises at least four dimensions from a group comprising manufacturer, model, year, mileage, color, and accessories.

Autotrader.com teach the steps wherein said object is a vehicle (See Page 1 of the reference) and wherein the dimensions comprises at least four dimensions from a group comprising manufacturer, model, year, mileage, color, and accessories (See page 2 of the reference). The dimensions such as manufacturer, model, year, mileage, color, and accessories are also old and well known in the art. Most classified ads for Autos carry information about these dimensions to help find the right buyer.

Both Autotrader.com and Sundaresan are concerned with the problem of facilitating trading between a buyer and a seller. It would have been obvious to one with ordinary skill in the art at the time of invention to include steps taught by Autotrader.com to the invention of Sundaresan. The combination of the disclosures taken as a whole suggests that it would have helped a car buyer find the right car according to his/her needs and preferences.

Response to Arguments

9.   Applicant's arguments with respect to claims 1- 7 and 10 have been considered but are

moot in view of the new grounds of rejection.

Conclusion

10.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

(a) Brodsky et al (US Patent 6,751,597 B1) (June 15, 2004) System and Method for

Adaptive trade Specification and Match-Making Optimization

(b) Peckover, D. L. (US Patent 6,119,101) (September 12, 200) Intelligent Agents for

Electronic Commerce

(c) Shear et al (US Patent 6,112,181) (August 29, 2000) Systems and Methods for

Matching, Selecting, Narrowcasting, and/or Classifying Based on rights Management and/or

Other Information

11.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is

(571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to

7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Vincent Millin can be reached at (571) 272-6747. The fax number for Formal or

Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PMR or Public PAIR. Status information for unpublished

applications is available through Private PMR only. For more information about the PMR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dr. N. Subramanian
October 22, 2005